

SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 3-15-02

APPL. S.N.: 09,970,558

TO EXAMINER: D. Jones

ART UNIT: 1614

MOSE MONTGOMERY ROOM 11E18

MAILROOM DATE 2-27-02

AFTER FINAL YES ☐ NO ☒ NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

☒ The T.D. is PROPER and has been recorded. (See 14.23).

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

☐ The recording fee of \$ _____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

☐ Application Examiner has not processed T.D. fee. (See fee authorization).

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

☐ It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).

☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

☐ Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

☐ Other: _____

☐ Suggestion to request refund of \$ _____. (See 14.35, 14.36).

☐ **EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP**

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).

☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).

☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)

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TERMINAL DISCLAIMER
Patent Application
Docket No. NPB-100D5
Serial No. 09/970,558

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner : Dwayne Jones
Art Unit : 1614
Applicant : Carver *et al.*
Serial No. : 09/970,558
Confirm. No. : 8233
Filed : October 4, 2001
For : Injectable Composition

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Assistant Commissioner for Patents
Washington, D.C. 20231

TERMINAL DISCLAIMER

Sir:

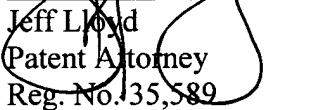
The owner of 100% interest in the instant application, NaPro BioThereapeutics, Inc., hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 for any of the following: U.S. Patent No. 6,306,894; issued October 23, 2001; U.S. Patent No. 6,140,359; issued October 31, 2000; U.S. Patent No. 5,977,164; issued November 2, 1999; and U. S. Patent No. 5,733,888; issued March 31, 1998. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and U.S. Patent No. 6,306,894; U.S. Patent No. 6,140,359; U.S. Patent No. 5,977,164; and U. S. Patent No. 5,733,888; are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any of U.S. Patent No. 6,306,894;

U.S. Patent No. 6,140,359; U.S. Patent No. 5,977,164; and U. S. Patent No. 5,733,888; in the event that the aforementioned patents: expire for failure to pay a maintenance fee, are held unenforceable, are found invalid by a court of competent jurisdiction, are statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, have all claims canceled by a reexamination certificate, are reissued, or are in any manner terminated prior to the expiration of their full statutory term.

- ☒ The undersigned is an attorney of record.
- ☒ I authorize you to charge the amount of \$55.00 (small entity) ☒ \$110 (large entity) for the terminal disclaimer fee under 37 CFR 1.20(d) to Deposit Account No.: 19-0065.

25 FEBRUARY 2002
Date


Jeff Lloyd
Patent Attorney
Reg. No. 35,589
Phone No.: 407-426-7500
Address: Saliwanchik, Lloyd & Saliwanchik
A Professional Association
1000 Legion Place, Suite 1750
Orlando, Florida 32801

JL/vc